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EXAMINER

SALL, EL HADJI MALICK

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHELL S. SIMPSON, WARD S. FOSTER,
and KRIS R. LIVINGSTON

Appeal 2008-0569
Application 09/940,200¹
Technology Center 2100

Decided: July 2, 2008

Before HOWARD B. BLANKENSHIP, JAY P. LUCAS, and STEPHEN C. SIU, *Administrative Patent Judges.*

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ Application filed August 27, 2001. The real party in interest is Hewlett Packard Development Company, LP.

STATEMENT OF CASE

Appellants appeal from a final rejection of claims 22 to 47 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

Appellants' invention relates to a system for automatically recognizing peripheral devices, such as printers, on a network, even when the printers are not attached to a network computer. In the words of the Appellants:

A system for recognizing devices connected in a distributed processing environment is disclosed. The system includes a client computer including a browser coupled to a network, a server computer coupled to the network, and a database coupled to the network, the database containing information that identifies devices coupled to the network. The client computer browses to a predefined web page and discovers from the database the presence of devices coupled to the network.

(Spec., 3, ll. 2-7).

Claims 22 and 32 are exemplary:

22. A method, comprising:

discovering devices directly connected to a network that are not directly connected to a computer; and

providing to a user via a network browser a list of at least one discovered device that is available for use on the network, wherein the list comprises at least one link to an available device.

32. A device discovery service stored on a computer-readable medium, the service comprising:

logic configured to discover devices directly connected to a network that are not directly connected to a computer; and

logic configured to provide a user home service accessible with a network browser with a list of at least one discovered device that is available for use on the network.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Carcerano	US 6,308,205 B1	Oct. 23, 2001 (filed Oct. 22, 1998)
Goshey	US 6,327,613 B1	Dec. 4, 2001 (filed Jan. 12, 1998)
Hemphill	US 6,490,617 B1	Dec. 3, 2002 (filed Jun. 9, 1998)

Rejections:

R1: Claims 22 to 26, 29 to 37, 42, 43, and 45 to 47 stand rejected under 35 U.S.C. § 102(e) for being anticipated by Goshey.

R2: Claims 27, 28, 38, 39, 40, 41, and 44 stand rejected under 35 U.S.C. § 103(a) for being obvious over Goshey in view of Carcerano.

Appellants contend that the claimed subject matter is not anticipated by Goshey, or rendered obvious by Goshey in combination with Carcerano, for failure of the references to teach the claimed limitations. The Examiner contends that each of the claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this opinion. Arguments which Appellants could have made but chose not to

make in the Briefs have not been considered and are deemed to be waived.
See 37 C.F.R. § 41.37(c)(1)(vii) (2006).²

We affirm the rejections.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. §§ 102(e) and 103(a). The issue turns on whether there is a legally sufficient basis for anticipating the limitations of the claims (or rendering them obvious) in the references.

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

² Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group, except as will be noted in this opinion. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. See *In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) that “claims must be interpreted as broadly as their terms reasonably allow.” Our reviewing court further states that “the words of a claim ‘are generally given their ordinary and customary meaning.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). The “ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Id.* at 1313.

Furthermore, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

From our review of the administrative record, we find that Examiner has presented a *prima facie* case for the rejections of Appellants’ claims under 35 U.S.C. §§ 102 and 103. The *prima facie* case is presented on pages 3 to 18 of the Examiner’s Answer. In opposition, Appellants present a number of arguments.

*Arguments with respect to the rejection
under 35 U.S.C. § 102(e) [R1]*

The first argument addresses the issue of whether Goshey teaches “discovering devices *directly connected to a network that are not directly connected to a computer*”. (App. Br., 8, middle). More specifically, Appellants argue that the peripherals in Goshey are directly connected to a computer. (App. Br., 9).

A key issue, then, is what constitutes the network in the Goshey reference. The full schematic labeled #110 of Figure 2A is entitled “[N]etwork [D]iagram”. (Col. 4, l. 32). The term “network” is thus, in a general way, applied to the full set of connected electrical devices depicted in Figure 2A. As such, the peripheral scanner, optical drive, etc., (#118, 120, etc.,) are part of the network. Are they directly connected to the network? It is evident that since the network comprises all of the items in the Figure, those peripherals are directly connected to the rest of the network – namely through their connection to the lines that connect to one of the host adapters. We are taking the plain meaning of the words network, connection and devices, as instructed by *Phillips v. AWH Corp.* (cited above), as we note that no special definition of the terms has been set aside in the Specification.

Appellants’ argument then alleges that those named peripherals, (#118, 120, etc.,) are directly connected to the computers, #112, contrary to the limitations of the claim. That simply is not the teaching of Goshey, as they are clearly connected “via a host adapter 116a” (col. 4, l. 38) and as depicted in Figure 2A.

Finally, Appellants contend “Nowhere in Figure 2C is a peripheral device directly connected to the network, which is clearly identified by a cloud containing the term “Network”. (App. Br., 9, bottom). That contention ignores the fact that #110 labels the schematic of Figure 2A as a network. The Board declines to take the lack of a depiction of a cloud in Figure 2A as evidence that it is not a network.

We thus agree with the Examiner’s interpretation of Goshey, expressed in tabular form for claim 22. (Answer, 19). We note that the Examiner has read the claimed network browser on the SCSI Explorer Window #202 of Figure 2D, and we concur in not finding Appellants’ contrary contention (App. Br., 11, top) convincing.

Appellants further argue that “Goshey further does not teach ‘creating a web service for a discovered device that is not a web enabled device, the web service enabling access and use of the discovered device via the network’.” (App. Br., 11, middle). We do not find this argument persuasive in view of the disclosures in Goshey of the ScanLan software itemized by the Examiner. (Answer, 8, top).

*Arguments with respect to the rejection
under 35 U.S.C. § 103(a) [R2]*

The Examiner has applied Goshey to claim 27 as interpreted for claim 26, and then remarked “Goshey fails to teach explicitly providing a list of available devices comprises providing a set of universal resource locators (URLs) to the home service, the URLs identifying locations of the available

devices.” (Answer, 14). The Examiner uses Carcerano for the missing teaching in rejecting the claims of R2 under 35 U.S.C. § 103(a).

Appellants contend that Carcerano does not remedy the deficiencies of the Goshey reference. (App. Br., 15).

As we have not supported the deficiencies of Goshey under 35 U.S.C. § 102, we now find Appellants’ contention unsupported.

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 22 to 26, 29 to 37, 42, 43, and 45 to 47 under 35 U.S.C. § 102(e) for being anticipated by Goshey. We also conclude that the Examiner did not err in rejecting claims 27, 28, 38, 39, 40, 41, and 44 under 35 U.S.C. § 103(a) for being obvious over Goshey in view of Carcerano.

OTHER ISSUES

REJECTION OF CLAIMS 32 TO 41 UNDER 37 C.F.R. § 41.50(B)

We make the following new ground of rejection using our authority under 37 C.F.R. § 41.50(b).

Rejection:

We reject claims 32 to 41 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 32 to 41 recite a computer readable medium. In the Specification, page 12, lines 9 through 24 the Appellants define computer readable medium as including an electromagnetic propagation medium, and “could even be paper.”

These claims are directed to a “service” stored on a computer-readable medium, the service comprising logic “configured” to perform functions. Logic, read with reasonable breadth, includes descriptive material indicating the algorithm or reasoning behind an operational computer program, not the program itself. As such the claims are addressed to nonfunctional descriptive material, which is non-statutory. “When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement.” *Manual of Patent Examining Procedure* (MPEP) § 2106.01 (Eighth Ed., Rev. 6, Sept. 2007).

Further, even if the “service” were claimed as a set of computer instructions, the “service” being stored on a computer-readable medium, according to Appellants a computer-readable medium “could even be paper” (Spec. p. 12, l. 21). -- i.e., a computer listing *per se*.

[C]omputer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs, are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural

and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized.

MPEP § 2106.01, Heading I.

A claim for logic embodied in a signal is also not considered by this office to be statutory under 35 U.S.C. § 101.³ This policy has recently been confirmed by the Court of Appeals for the Federal Circuit in *In re Nuijten*. “A transitory, propagating signal like Nuijten's is not a ‘process, machine, manufacture, or composition of matter’. Those four categories define the explicit scope and reach of subject matter patentable under 35 U.S.C. § 101; thus, such a signal cannot be patentable subject matter.” *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007).

DECISION

The Examiner's rejections of claims 22 to 47 are affirmed.

Claims 32 to 41 are rejected under 35 U.S.C. § 101.

We have sustained the Examiner's prior art rejections with respect to claims 22 to 47, all the claims on appeal. Moreover, we have entered a new ground of rejection under 37 C.F.R. § 41.50(b) for claims 32 to 41 as failing to recite statutory subject matter under 35 U.S.C. § 101.

³ See also "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility," 1300 Off. Gaz. Pat. Office 142, Annex IV(c) (Nov. 22, 2005).

With respect to the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides that “Appellant may file a single request for rehearing within two months from the date of the original decision of the Board.”

In addition to affirming the Examiner’s rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

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If Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED
37 C.F.R. § 41.50(b)

rwk

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